

Application No.: 09/940,737

**REMARKS:**

The present amendment is in response to the Office Action received on Sep. 29, 2004, in which Claims 1-6, 11-17 and 24-28 were rejected. Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the reference cited therein. The following remarks are believed to be fully responsive to the Office Action and render all claims at issue patentably distinguishable over the cited references.

Reconsideration and withdrawal of the rejections set forth in the Office Action dated Sep. 29, 2004 are respectfully requested.

**I. Claim Rejections - 35 U.S.C. § 103**

Rejection of Claims 1-6 and 11-17 under 35 U.S.C. 103(a) as being unpatentable over Herzog (US Patent, No. 6,353,737) and in view of Verstijnen (US Patent, No. 5,733,147) and Japanese document 63,168,755

Claims 1-6 and 11-17 are withdrawn, and the patentability of added Claims 33-50 is discussed with cited prior arts.

According to Claim 33, a system for SIM card backup is provided. Herzog disclosed the SIM card connection, the processor, memory, the power supply and the input means, but failed to disclose the backup mechanism of data in SIM card. In accordance with the specification of the present application, one of the main purposes of the present invention is the backup of data in SIM cards. Therefore, the data security of SIM cards is the most significant feature of the present invention, and results of the claimed system certainly can not be expected by Herzog.

However, the Examiner believed that the disclosure of Herzog combined with Verstijnen and the Japanese document may make the present application obvious to one having ordinary skill in the art. According to the Japanese document, a backup system for IC card is disclosed. The Japanese document failed to disclose any input means for controlling the backup operation and any displayer for showing the data in the IC card or the memory. It should be noted that the backup mechanism, namely the manipulation of backup operation,

Application No.: 09/940,737

including the input means for inputting instructions and the processor for controlling the backup process in Claim 33, is crucial in the present invention, yet all of the three citations fails to disclose such critical characteristics of the present invention. Pursuant to *Papesch*, "the presence of a property not possessed by the prior art is evidence of nonobviousness,"<sup>1</sup> the combination of the Japanese document, Verstijnen and Herzog can not render the present invention obvious or unpatentable.

Since Claims 34-38 depend on Claims 33, all of them should be patentable under the patentability of Claim 33.

Claims 39 and 46 respectively disclose a communication device and a PDA, and both apparatuses are provided with the SIM card backup mechanism. Again, the combination of the Japanese document, Verstijnen and Herzog fails to teach the backup mechanism of the present invention, and therefore can not render the present invention obvious or unpatentable.

In addition, the communication device of Claim 39 integrates the phone (including cellular phone and telephone) and the SIM card backup system. According to Herzog, the device therein merely uses the SIM card for identification, which is the basic function of SIM, and the input means is merely used for dialing someone else. Referring to the Japanese document, the IC card backup system only transferring the data between the IC card and the memory. There is no mention about the identification or communication functions. Hence, the Japanese document, Verstijnen and Herzog fail to teach not only the backup mechanism but also the integration of communication, identification and SIM card backup system. The noteworthy results of the present invention are unexpected for the cited prior arts. Since absence of property which a claimed invention would have been expected to possess based on the teachings of the prior art is evidence of unobviousness<sup>2</sup>, the Claims 39 and 46 are surely unobvious in view of the three citations.

Besides, throughout the disclosure of the three citations, there is no attempt to combine the communication device with the SIM card backup system. Therefore, the communication device with SIM card backup mechanism is naturally unobvious over the three citations.

---

<sup>1</sup> *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)

<sup>2</sup> *Ex parte Mead Johnson & Co.* 227 USPQ 78 (Bd. Pat. App. & Inter. 1985)

Application No.: 09/940,737

Since Claims 40-45 and 47-50 respectively depend on Claims 39 and 46, all of them should be patentable under the patentability of Claims 39 and 46.

In conclusion, Claims 33-50 should be unobvious since their results are unexpected to the three citations and the combination thereof.

Rejection of Claims 24-28 under 35 U.S.C. 103(a) as being unpatentable over Herzog in view of Verstijnen, Japanese document 63,168,755 and Erola (US Patent, No. 6,353,737)

Claims 1-6 and 11-17 are withdrawn, and the patentability of added Claims 33-50 is discussed with cited prior arts.

Erola disclosed the usage of SIM card in a PDA. The SIM card used in the PDA of Erola is merely applied for identification, which is the basic function of SIM. With the same reason described above, Erola combined with other three citations still fails to teach the main characteristics of the present invention, and therefore the present invention is unobvious and patentable over the four citations of prior art.

It should be noted that the Examiner cited four citations from diverse technical fields, but the properties which the claimed invention would have been expected to possess are still absent based on the teachings of the prior arts. Accordingly, the present invention is certainly unobvious and patentable because of the failure of others, which is one of the secondary considerations as the matter of unobviousness. Besides, throughout the disclosure of the four citations, there is no attempt to combine the PDA with the SIM card backup system. Therefore, the PDA with SIM card backup mechanism is naturally unobvious over the four citations.

Since Claims 47-50 respectively depend on Claim 46, all of them should be patentable under the patentability of Claim 46.

In conclusion, Claims 46-50 should be unobvious since their results are unexpected to the three citations and the combination thereof.

Application No.: 09/940,737

Applicant believes that the response traverses the rejection under 103. Reconsideration and withdrawal of these rejections under 103 set forth in the Office Action are respectfully requested.

## II. Conclusion

In view of the foregoing, Claims 33-50 pending in the application comply with the requirements of patentability define over the applied art. A Notice of Allowance is, therefore, respectfully requested.

  
Clement Cheng, Esq.  
Plaza Del Lago Building  
17220 Newhope St #127  
Fountain Valley, CA 92708  
www.clemcheng.com

Application No.: 09/940,737

**Listing of Claims:**

7. A method for operating a subscriber identity module card backup system, comprising: inserting a first subscriber identity module card into a subscriber identity module card connector of said subscriber identity module card backup system; extracting and backing up a first storage data from said first subscriber identity module card to a memory whereby a central processing unit; removing said first subscriber identity module card from said subscriber identity module card connector; inserting a second subscriber identity module card into said subscriber identity module card connector; and duplicating said first storage data from said memory into said second subscriber identity module card in order to back up said first storage data from said first subscriber identity module card to said second subscriber identity module card.
8. The method according to claim 7, wherein said subscriber identity module card comprises a plurality of subscriber identity module cards.
9. The method according to claim 7, wherein said memory comprises flash memory.
10. The method according to claim 7, wherein said memory comprises electrically erasable programmable read only memory (EEPROM).
18. A method for operating a telecommunication device with a subscriber identity module card backup system, comprising: inserting a first subscriber identity module card into a subscriber identity module card connector of said subscriber identity module card backup system; extracting and backing up a first storage data from said first subscriber identity module card to a memory whereby a central processing unit; removing said first subscriber identity module card from said subscriber identity module card connector; inserting a second subscriber identity module card into said subscriber identity module card connector; and duplicating said first storage data from said memory into said second subscriber identity module card in order to back up said first storage data from said first subscriber identity module card to said second subscriber identity module card.
19. The method according to claim 18, wherein said telecommunication device comprises telephone.
20. The method according to claim 18, wherein said telecommunication device comprises mobile phone.

Application No.: 09/940,737

21. The method according to claim 18, wherein said subscriber identity module card comprises a plurality of subscriber identity module cards.
22. The method according to claim 18, wherein said memory comprises flash memory.
23. The method according to claim 18, wherein said memory comprises electrically erasable programmable read only memory (EEPROM).
29. A method for operating a personal digital assistant with a subscriber identity module card backup system, comprising: inserting a first subscriber identity module card into a subscriber identity module card connector of said subscriber identity module card backup system; extracting and backing up a first storage data from said first subscriber identity module card to a memory whereby a central processing unit; removing said first subscriber identity module card from said subscriber identity module card connector; inserting a second subscriber identity module card into said subscriber identity module card connector; and duplicating said first storage data from said memory into said second subscriber identity module card in order to back up said first storage data from said first subscriber identity module card to said second subscriber identity module card.
30. The method according to claim 29, wherein said subscriber identity module card comprises a plurality of subscriber identity module card.
31. The method according to claim 29, wherein said memory comprises flash memory.
32. A method for operating an apparatus with a subscriber identity module card backup system, comprising: inserting a first subscriber identity module card into a subscriber identity module card connector of said subscriber identity module card backup system; extracting and backing up a first storage data from said first subscriber identity module card to a memory whereby a central processing unit; removing said first subscriber identity module card from said subscriber identity module card connector; inserting a second subscriber identity module card into said subscriber identity module card connector; and extracting and backing up a second storage data from said second subscriber identity module card to a memory whereby a central processing unit.
33. A backup system comprising:
  - a memory for storing digital data;
  - a processor coupled to said memory for controlling the data exchange;

Application No.: 09/940,737

- a connector coupled to said processor for holding and connecting a first SIM card (subscriber identity module card) and transfers data of said first SIM card to said memory;
  - an input means for inputting instructions to said processor;
  - a power supply coupled to said processor for providing power;
  - a displayer coupled to said processors for displaying said data;
  - wherein said processor restores said data from to a second SIM card according to said inputting instructions.
34. The system as set forth in claim 33, wherein said memory comprises flash memory.
35. The system as set forth in claim 33, wherein said memory comprises electrically erasable programmable read only memory (EEPROM).
36. The system as set forth in claim 33, wherein said display comprises a liquid crystal display.
37. The system as set forth in claim 33, wherein said display comprises a light emitting diode display.
38. The system as set forth in claim 33, wherein said inputting device comprises a keypad.
39. A communication device comprising:
- a memory for storing digital data;
  - a processor coupled to said memory for controlling the operation of said communication device;
  - a connector coupled to said processor for holding and connecting a first SIM card (subscriber identity module card) and transfers data of said first SIM card to said memory;
  - an input means for inputting instructions to said processor;
  - a power supply coupled to said processor for providing power;
  - a displayer coupled to said processors for displaying said data; and
  - a communication module coupled to said processor for transmitting and receiving signals;
  - wherein said processor restores said data from to a second SIM card according to said inputting instructions.
40. The communication device as set forth in claim 39, wherein said communication module includes a telephone.
41. The communication device as set forth in claim 39, wherein said communication module includes a mobile phone.

Application No.: 09/940,737

42. The communication device as set forth in claim 39, wherein said memory comprises flash memory.
43. The communication device as set forth in claim 39, wherein said memory comprises electrically erasable programmable read only memory (EEPROM).
44. The communication device as set forth in claim 39, wherein said display comprises a liquid crystal display.
45. The communication device as set forth in claim 39, wherein said inputting device comprises a keypad.
46. A personal digital assistant (PDA) comprising:
  - a memory for storing digital data;
  - a processor coupled to said memory for controlling the operation of said communication device;
  - a connector coupled to said processor for holding and connecting a first SIM card (subscriber identity module card) and transfers data of said first SIM card to said memory;
  - an input means for inputting instructions to said processor;
  - a power supply coupled to said processor for providing power;
  - a displayer coupled to said processors for displaying said data; and
  - an assistant module coupled to said processor for managing personal data;wherein said processor restores said data from to a second SIM card according to said inputting instructions.
47. The personal digital assistant as set forth in claim 46, wherein said memory comprises flash memory.
48. The personal digital assistant as set forth in claim 46, wherein said display comprises a liquid crystal display.
49. The personal digital assistant as set forth in claim 46, wherein said inputting device comprises a keypad.
50. The personal digital assistant as set forth in claim 46, wherein said inputting device comprises a touch screen panel.



PTO/SB/97 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

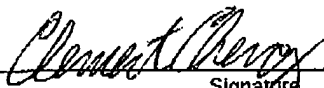
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

## Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the  
United States Patent and Trademark Office

on 12/28/2004  
Date



Signature

Clement Cheng, Esq.  
Plaza Del Lago Building  
17220 Newhope St # 127

Typed or Printed Name of Person Preparing Certificate  
Fremont Valley, CA 92708  
www.clemcheng.com

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

faxed to (703) 872-9306  
PST 5:13 PM

Burden Hour Statement: This form is estimated to take 0.03 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.